

#Reg
for
Recon

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Paul E. Massod
Serial No. : 09/334,574
Filed : June 21, 1999
Title : VERIFICATION PROCESS FOR DRY CLEANERS AND THE LIKE

Art Unit : 2876
Examiner : Diane Lee

Board of Patent Appeals and Interferences
Commissioner of Patents and Trademarks
Washington, DC 20231

REQUEST FOR RECONSIDERATION OF THE
DECISION ON APPEAL DATED AUGUST 17, 2004

RECEIVED
2004 OCT 22 AM 10:59
BOARD OF PATENT APPEALS
AND INTERFERENCES

Sirs:

Appellant respectfully requests reconsideration of the Board of Patent Appeals and Interferences Decision on Appeal dated August 17, 2004, Paper No. 29, under 37 CFR 1.197(b). Appellant believes the Board misapprehended or overlooked the following points in rendering their decision.

I. Appellants' invention

As stated in Appellant's opening brief, Appellant conceived a new technique and apparatus to verify that articles were correctly grouped into groups. In particular, Appellant conceived using logic to indicate when a scanned article did not belong to a group of articles. Appellant's invention offers several non-obvious and important advantages over the more complicated system taught in the prior art. Particularly, for small establishments, e.g., small dry cleaners that may have made a substantial investment in manual grouping systems, this invention capitalizes on that investment by establishing a verification system that can catch the infrequent but costly regrouping mistakes that occur.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date of Deposit October 15, 2004

Signature

Marie G. Collins

Marie G. Collins

Typed or Printed Name of Person Signing Certificate

II. The Board ignored teachings of the cited prior art.

Claims 1-4, 6-16, 18-26 and 34-36 stand rejected under 35 U.S.C. §103(a) as being obvious over Markman (U.S. Patent 5,794,213).

The Board finds that: "the examiner's analysis ... correctly establishes correspondence between the claimed physical grouping of articles and that disclosure of Markman (Col. 5, lines 23-47; column 10, line 66 through column 11 line 13)." The Board also states that: "We do not necessary disagree with Appellant's assertion that unlike the disclosed verification method which operates on grouped articles to verify a correct grouping, Markman's system operates on ungrouped articles to assemble them in the correct grouping." The Board then states" "It is the claimed invention which is before us on appeal." (Emphasis in original)

The Board implies that what Appellant argued in the main brief was different from what Appellant claimed. However, claim 1 clearly recites a method of inventory management including verifying that articles, which were physically grouped by a manual or automated grouping process into a physically grouped order, belong to the physically grouped order. Claim 1 also requires examining codes on tags *** to determine that the article belongs in the grouped order and positively indicating to an operator if the scanned unique sequential code does not correspond to an item that belongs in the grouped order. Appellant did not advance any arguments that were inconsistent with the elements recited in claim 1 and the Board has not pointed out specifically where Appellant was arguing its disclosure rather than Claim 1. For this reason alone the Board should reconsider its decision.

The Board misconstrues the teachings of Markman by advancing an argument that: "from Markman's disclosure the verification of the correctness of the group assembling operation at the output side of the dry cleaning process relates to a physical grouping performed at the customer input side." The Board cites no passage from Markman to support this argument.

The Board is in error because according to Markman and common sense, there is no grouping performed at the customer input side, which the Markman system can verify, because when Markman operates on the articles it is after the articles have been commingled with other articles from different customers and possibly from different lots during the cleaning process. When a customer brings articles into a cleaning establishment, in general there would not be any

indicia on the articles that identify the articles as belonging to a particular group of articles that Markman's system and method could verify. Further, Markman does not mention verification, rather only mentions grouping. So, it is clear that at the customer input side there is not any group for the Markman system to verify. In practical use, Markman's system receives many commingled articles after cleaning, which a user then assembles into groups. These articles could be from many groups and from different lots of groups.

Appellant's claimed invention becomes operative after assembly, or in the words of Claim 1; verifying that articles, which were physically grouped by a manual or automated grouping process into a physically grouped order. Appellant's claimed verification method occurs in a different point of inventory management than Markman's grouping method. Appellant's method, as in claim 1, occurs on articles, which were physically grouped by a manual or automated grouping process into a physically grouped order, whereas Markman's process is operative to group individual articles in the first instance. Clearly, there is no suggestion that the customer input side qualifies as a manual grouping process as pointed out above.

III. The Board misapprehended Markman to improperly advance an anticipation rejection.

The Board effectively modified the examiner's rejection of Claims 1-4, 6-16, 18-26 and 34-36, as being obvious under 35 U.S.C. §103(a) over Markman (U.S. Patent 5,794,213) into a rejection of those claims as being anticipated by Markman under 35 U.S.C. §102(b).

The initial obviousness rejection was improper because neither the examiner nor the Board made a *prima facie* case for obviousness. Obviousness is determined from the vantage point of hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). This legal construct presumes that all prior art references in the field of the invention are available to this hypothetical artisan. See *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) *citations omitted*.

Framed as an anticipation rejection, this rejection is equally improper, since Markman neither discloses nor teaches each and every element of the claims. It is equally well settled, that "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed

invention arranged as in the claim." (See *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983). As pointed out above, Markman does not describe any verification process. Markman also does not possess logic that can produce an indication to positively indicate to an operator if the scanned unique sequential code does not correspond to an item that belongs in the grouped order, as required by these claims.

For example, independent claim 1 is directed to a method of inventory management. Claim 1 calls for verifying that articles, which were physically grouped by a manual or automated grouping process into a physically grouped order, belong to the physically grouped order. One of the advantages of Appellant's invention, the ability to verify the correctness of the group of an order, is positively recited in this element of claim 1. The Board (opinion page 5) overlooks this. Claim 1 also includes the elements needed to accomplish verification, by examining unique identifier codes on the tags, each tag associated with one article in the group to determine that the article belongs in the grouped order. The method includes the limitation of positively indicating to an operator if the scanned unique code does not correspond to an item that belongs in the grouped order.

The Board's independent analysis misconstrues Markman and logically is incorrect. The Board states that "... the described operation of the signal light indicators 92 associated with the storage locations 94 provides a positive indication to an operator that a scanned item does not belong to a particular grouped order." However, in Appellant's brief Appellant refuted the illogic of this argument when the examiner advanced the same argument. Clearly, Markman's system is not capable of satisfying this action so that one could be "confident," as the Board chooses to define "positive," that Markman's system, would in fact, verify the correct grouping. This follows because Markman does not know whether an article belongs in a group from one lot or a different group from another lot. Therefore, that is precisely why Markman does not possess a verification system but only possesses a grouping system that can cause errors, and why Appellant's verification method can operate on either manually or physically grouped articles.

Appellant set out below the argument from the Brief, which refutes the same reasoning made by the examiner. At page 10 line of the Brief on Appeal Appellant stated:

The recited feature of positively indicating that an article does not belong in a group is missing from Markman. First, indicating some group to place an article does not equate to positively indicating that the article does not belong in that group. Second, one could consider what would happen if an operator were to mix two different lots of groups. An operator can be grouping a first lot of items that corresponds to a certain number of groups of an order. All of the groups in that lot are assigned stations. The second lot would have all of the groups assigned to the same stations. Since the stations are all preassigned, when the operator is grouping the first lot, Markman does not have mechanism to positively indicate that an item from the second lot of groups does not belong in any group in the first lot. Rather, Markman would incorrectly assign it to some group in the first lot. Thus, there is no teaching of positively indicating that an article does not belong in a group.

Accordingly, the Board has not advanced a position different from the examiner and has not shown where Markman discloses these features of the claimed invention.

IV. The Board overlooks the absence of any suggestion to use unique sequential identifiers in grouping articles"

Claims 3, 10, 15 and 22 stand rejected under 35 U.S.C. §103(a) as being obvious over Markman (U.S. Patent 5,794,213).

Claim 3 is representative of this group of claims. Claim 3 is directed to the feature of having tags that have unique sequential identification and scanning the unique sequential identification. Markman shows bar codes, but Appellant argued that these bar codes do not have unique sequential identifications because each bar code in Markman identifies a group. The Board takes the position that: "there is no language in appealed claim 3 that require sequential identification in the form of bar codes." Appellant does not disagree with this statement, and did not argue that claim 3 was limited to bar codes, but pointed out that the bar codes in Markman did not correspond to "unique sequential identifications." But, what is missing from the Board's analysis is that Markman does not utilize a system that possess "unique sequential identifications" whether in the form of bar codes and or machine readable text. Markman does not suggest these unique sequential identifications and thus cannot suggest claim 3. Further,

because Markman does not possess "unique sequential identifications" only serves to reinforce that Markman does not suggest the feature of base claim 1 "positively indicating to an operator if the scanned unique sequential code does not correspond to an item that belongs in the grouped order."

V. The absence of unique sequential identifiers in grouping articles mandates reversal of the rejection of claims 4 and 7.

Claims 4 and 7 and their respective grouped claims 6, 16 and 18 (claim 4), and claims 9 and 19-21 (claim 7) are allowable with claim 3.

VI. The combination of references still does not suggest Appellant's claimed invention.

This claim group deals with indicating to an operator that the verification process has started, ended successfully, or ended unsuccessfully. The Board takes the position that the Appellant focused unpersuasively on individual differences between the references and the claims. However, that is the very essence of attacking a combination of references to show that neither of the references suggests the desirability of accomplishing something. In this case, neither Markman nor Amacher separately or in combination teach or suggest verification and therefore, cannot teach when verification has started, ended successfully, or ended unsuccessfully.

Applicant : Paul E. Massod
Serial No. : 09/334,574
Filed : June 21, 1999
Page : 7 of 7

Attorney's Docket No.: 10925-002001

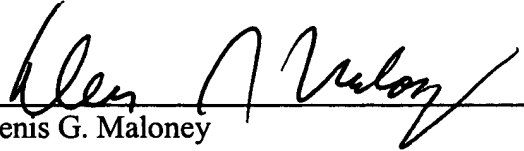
VII. Conclusion

Reconsideration and modification of the Board's August 17, 2003 decision is requested.
Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: _____

10/15/04



Denis G. Maloney
Reg. No. 29,670

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906